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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,630	07/19/2001	Yakov Kamen	007287.00016	9979
22907 7590 05/27/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER CASCHERA, ANTONIO A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 05/27/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/909,630

Applicant(s)

KAMEN, YAKOV

Examiner

Antonio A. Caschera

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-17 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-17 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Priority

1. Acknowledgment is made of Applicant's claim for domestic priority under 35 U.S.C. 119(e). This application claims the benefit of application no. 60/241,885, filed 10/19/2000.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

With reference to the claim language of claims 21-27, these claims comprise the language, "machine-readable storage medium" which the specification fails to provide proper antecedent basis for. The specification does clearly define the term, "computer-readable medium drive" (see paragraph 17 of the specification) however the explicitly used language of the claim is nowhere to be found in the specification and thus is not provided with proper antecedent basis. Note, Applicant's specification further does not seem to limit the "medium" to a physical storage type of memory since in paragraph 18 of the specification, Applicant clearly defines one form of "machine readable media" as other forms of propagated signals. This can reasonably lead one of ordinary skill in the art to equate the computer media or memory to a non-statutory storage media/medium therefore an applicable 35 USC 101 rejection is valid in this case.

Claim Objections

3. Claim 21 is objected to because of the following informalities:
- a. The phrase, "A machine-readable storage medium embodying a sequence of instructions executable by the machine..." (see lines 1-2 of the claim) should read, "A machine-readable storage medium embodying a sequence of instructions executable by a machine..." in order to provide proper antecedent basis.
- Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-17 and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to claim 11 (and all dependent upon claim 11 claims), the language of the claims raise questions as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, newly implemented practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the antecedent basis for the claimed terminology of a "memory" as recited in claim 11. The specification does clearly suggest to one of ordinary skill in the art that such a "memory" or "media" could be one of signals, or other forms of propagation and transmission media (page 8, paragraphs 17-18 of

Applicant's specification) which fail to be an appropriate manufacture under 35 U.S.C. 101 in the context of computer-related inventions and therefore requires the rejection of claims 11-17 of which comprise such a term, "memory."

In reference to claim 21 (and all dependent upon claim 21 claims), the language of the claims raise questions as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, newly implemented practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the antecedent basis for the claimed terminology of a "machine-readable storage medium embodying a sequence of instructions..." as recited in claim 21. The specification of the instant application does not explicitly define the term, "machine-readable storage medium" however it does mention various forms of a "computer-readable medium drive" capable of storing instructions for implementing the processing of data as detailed in the claims (see page 8, paragraphs 17-18 of Applicant's specification). The specification does clearly suggest to one of ordinary skill in the art that such a "machine-readable storage medium" could be one of signals, or other forms of propagation and transmission media (page 8, paragraph 18 of Applicant's specification) which fail to be an appropriate manufacture under 35 U.S.C. 101 in the context of computer-related inventions and therefore requires the rejection of claims 21-27 of which comprise such a term, "machine-readable storage medium."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 and 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claims 1 and 11, from which claims 2-7 and 12-17 depend upon respectively, claims 1 and 11 comprise the phrased limitation of, "...wherein modifying the attribute for at least two times that the object is selected occurs in a common direction," (see limitation (b) of each claim 1, for example). Such a limitation is indefinite as it fails to particularly point out what the applicant regards as the invention. Specifically, the term "in a common direction" as it is applied in the claim language of claims 1 and 11, is unclear as it fails to exactly define what is meant by "in a common direction." The Office believes Applicant is attempting to capture the element described in the specification in paragraph 11, directed to selecting of an object consecutively however "in a common direction" is surely not equivalent to consecutively. The Office believe consecutively to signify, "one after another" therefore in this context, a selection of an object is made, the selections being made are one after another however, such does not necessarily signify that the selections are being made "towards a common direction." The Office requires a modification of the claim language to at least better describe what the Applicant attempts to claim with the phrase, "in a common direction."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (U.S. Patent 6,075,575).

In reference to claim 1, Schein et al. discloses a method comprising:

(a) receiving a selection of an object displayed in an electronic programming guide (EPG) (see column 5, lines 6-47, column 8, lines 37-39, 50-52, column 9, lines 17-18, 27-36 and Figures 2 and 4A wherein Schein et al. discloses a method for using television schedule information using a remote control whereby the television schedule information GUI comprises vertical and horizontal scroll bars. Such scroll bars manipulated via the remote control thumb device and further control buttons. The Office interprets that as such a scrolling button(s) is depressed it is inherently selected as its visual appearance is changed to conform to television schedule data (see #32, 120 of Figure 4A).);

(b) *modifying a non-textual attribute associated with the object by an incremental amount for each of at least two times that the object is selected, wherein modifying the attribute for at least two times that the object is selected occurs in a common direction*, wherein each modification of the attribute includes changing a visible characteristic of the object and wherein each modification results in a different appearance of the object (see column 9, lines 17-18, 27-36 and #120 of Figure 4A wherein Schein et al. discloses “selection” of the scroll bar via a selection of a remote control scroll button, which in turn forces the scrolling of television

schedule information to be changed. Also, Schein et al. explicitly discloses the scroll bar being visually proportional to the total information in the television schedule program matrix thereby changing the visual appearance of the scroll bar to conform to the information displayed in the matrix.); and

(c) modifying the display of the object in accordance with the modified non-textual attribute (see column 9, lines 17-18, 27-36 and #120 of Figure 4A wherein Schein et al. explicitly discloses the scroll bar being visually proportional to the total information in the television schedule program matrix thereby changing the visual appearance of the scroll bar to conform to the information displayed in the matrix.).

Although Schein et al. does disclose an explicit association between the scroll bar and the information of program matrix, Schein et al. does not explicitly disclose a non-textual attribute associated with the scroll bar being modified by an incremental amount. However, it is well known in the art of computer graphics and particular in computer graphical user interface processing that scroll bars, when selected/operated, change an associated non-textual attribute, the attribute being 2D location of the "scroller" within the "trough." Such a change in visual 2D positioning of the "scroller" within the "trough" is incrementally changed in accordance to the number of times the scroll bar is selected/operated in either a common direction or opposite direction based upon the amount of information being scrolled through vs. the amount of information being displayed at one time (Official Notice). It would have been obvious to one of ordinary skill in the art at the time the invention was made for Schein et al. who teaches utilizing scroll bars in a television EPG display, to use a scroll bar which modifies its visual appearance incrementally based upon amount of data available for display vs. amount of data displayed at

one time, because it is well known in the art that scroll bars are known to operate in such a manner and are utilized to scroll through a multitude of data. (see *Response to Arguments* below)

In reference to claim 11, claim 11 is equivalent in scope to claim 1 and is therefore rejected under similar rationale. In addition to the rationale applied to claim 11, claim 11 recites an apparatus comprising a processor and memory configured to store computer readable instructions that when executed, cause the processor to perform the steps as recited. Schein et al. discloses the invention to comprise of a system for use with the remote control, the system made up of a computer which further comprises a processor and memory (i.e. hard drive and disk input) that embodies a computer program providing the software needed for receiving, organizing and displaying data for the television program guide (see columns 6-7, lines 60-41 and Figure 3).

In reference to claim 21, claim 21 is equivalent in scope to claim 1 and is therefore rejected under similar rationale. In addition to the rationale applied to claim 21, claim 21 recites a machine-readable storage medium embodying a sequence of instructions executable by the machine to perform a method as recited. Schein et al. discloses the invention to comprise of a system for use with the remote control, the system made up of a computer which further comprises a processor and memory (i.e. hard drive and disk input) that embodies a computer program providing the software needed for receiving, organizing and displaying data for the television program guide (see columns 6-7, lines 60-41 and Figure 3).

Response to Arguments

7. Applicant's arguments, see pages 6-8 of Applicant's Remarks, filed 03/03/08, with

respect to the 35 USC 102 rejection of claims 1 and 11, in view of Kohno et al., have been fully considered and are persuasive. The 35 USC 102 rejection of claims 1 and 11 has been withdrawn since amendments to the claims overcome Kohno et al.. However, upon further consideration, a new ground(s) of rejection is made in view of Schein et al..

8. Applicant's arguments, see pages 6-8 of Applicant's Remarks, filed 03/03/08, with respect to the 35 USC 102 rejection of claim 21, in view of Lee et al., have been fully considered and are persuasive. The 35 USC 102 rejection of claim 11 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Schein et al..

9. Applicant's arguments filed 03/03/08 have been fully considered but they are not persuasive.

In reference to claims 21-24, the Applicant argues the 35 USC 101 rejection of claims 21-27 such that Applicant believes the term "machine-readable storage medium" satisfies 35 USC 101 (see page 6 of Applicant's Remarks).

In response, the Office points to the above 35 USC 101 rejection of claims 21-27 and the above objection of the specification. It is because the specification does not clearly define the claimed "machine-readable storage medium" and further offers the possibility of any type of medium being of non-statutory (i.e. one that carries waves, propagation signals etc) type that the claims still remain rejected under 35 USC 101. The mere fact that the claims recite a storage medium does not automatically warrant a statutory limitation especially when the specification a) does not provide an explicit mentioning of the term and b) since the specification suggests to one of ordinary skill in the art that any type of medium can be deemed a propagation signal medium, carrier wave etc. type medium which is of course, seen as non-statutory. Therefore, the Office

maintains its rejection, based upon such reasoning, of claims 21-27 under 35 USC 101. Note, claim 11, suffers from a similar issue with the reciting of the term "memory."

Lastly, the Office notes, in view of independent claims 1, 11 and 21, that the "object" which is selected in the EPG of the claims, is not necessarily recited as a programming object or being directed to the informational content of the EPG. Therefore, the Office has applied the "scroll bar selection" of Schein et al. to the claims in combination with the well-known functionality of GUI scroll bars.

Allowable Subject Matter

10. Claims 2-7, 12-17 and 22-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Further, such claims also suffer from 35 USC 101 issues which must be addressed in order for them to be deemed in condition for allowance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00 AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

/Antonio A Caschera/

Examiner, Art Unit 2628

5/27/08